

**UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE COMMISSIONER OF PATENTS AND TRADEMARKS**

)	
)	Decision on
In re)	Petition for Regrade
)	Under 37 C.F.R. § 10.7(c)
_____)	

MEMORANDUM AND ORDER

(Petitioner) petitions for regrading his answers to questions 18, 26, 32, 35, 43 and 50 of the morning section of the Registration Examination held on August 26, 1998. The petition is denied to the extent that Petitioner seeks a passing score for the morning section of the Registration Examination.

BACKGROUND

An applicant for registration to practice before the Patent and Trademark Office (PTO) in patent cases must achieve a passing grade of 70 in both the morning and afternoon sections of the Registration Examination. Petitioner scored 64 on the morning section. On December 17, 1998, Petitioner requested regrading of six two-point questions on the morning section, arguing that the model answers were incorrect.

As indicated in the instructions for requesting regrading of the Examination, in order to expedite a petitioner's appeal rights, all regrade requests have been considered in the first instance by the Commissioner.

OPINION

Under 37 C.F.R. § 10.7(c), Petitioner must establish any errors that occurred in the grading of the examination. The directions state: "No points will be awarded for incorrect answers or unanswered questions." The burden is on petitioners to show that

their chosen answers are the most correct answers. Petitioner has failed to meet this burden.

The directions to the morning section state in part:

Do not assume any additional facts not presented in the questions. When answering each question, unless otherwise stated, assume that you are a registered patent practitioner. Any reference to a practitioner is a reference to a registered patent practitioner. The most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the PTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a subsequent court decision or a notice in the *Official Gazette*. There is only one most correct answer for each question. Where choices (A) through (D) are correct and choice (E) is "All of the above," the last choice (E) will be the most correct answer and the only answer which will be accepted. Where two or more choices are correct, the most correct answer is the answer which refers to each and every one of the correct choices. Where a question includes a statement with one or more blanks or ends with a colon, select the answer from the choices given to complete the statement which would make the statement *true*. Unless otherwise explicitly stated, all references to patents or applications are to be understood as being U.S. patents or regular (non-provisional) utility applications for utility inventions only, as opposed to plant or design applications for plant and design inventions. Where the terms "USPTO," "PTO," or "Office" are used in this examination, they mean the U.S. Patent and Trademark Office.

Petitioner has presented various arguments attacking the validity of the model answers. All of Petitioner's arguments have been considered. For the following reasons, two points will be added to Petitioner's score for the morning section of the Examination.

Question 18 reads as follows:

18. Which of the following statements regarding design patent applications is not correct?

- (A) The specification may contain a brief description denoting the nature and environmental use of the claimed design.
- (B) The drawings may be color drawings or color photographs if accompanied by a grantable petition.
- (C) The design application may have only a single claim.
- (D) Different embodiments or modifications may be set forth in the specification, but do not need to be shown in the drawings.
- (E) The inventive novelty or unobviousness of a design resides in the shape or configuration, and/or surface ornamentation of the subject matter which is claimed.

Answer (D) is correct and Petitioner selected answer (B). Choice (D) is the most correct answer because “it is permissible to illustrate more than one embodiment of a design invention in a single application.” MPEP § 1504.05(II)(A); *see also In re Rubinfeld*, 270 F.2d 391, 393, 123 USPQ 210, 212 (CCPA 1959) (“we see no reason why . . . 35 U.S.C. § 171 should, per se, preclude the showing of two or more embodiments of a design invention”). Additionally, “[t]he design must be represented by a drawing that complies with the requirements of § 1.84, and must contain a sufficient number of views to constitute a complete disclosure of the appearance of the design.” 37 C.F.R. § 1.152(a). Accordingly, when there are different embodiments of a design, compliance with the rule’s provision that there be a sufficient number of views to constitute a “complete” disclosure of the design requires that each embodiment be set forth in the drawings. Therefore, different embodiments or modifications of a design need to be shown in the drawings.

Answer (B) correctly states that the drawings may be color or color photographs if accompanied by a grantable petition. 37 C.F.R. § 1.152(a)(2). Answer (B) is therefore an incorrect answer choice to the question reading “[w]hich of the following statements regarding design patent applications is not correct” (emphasis in original).

Petitioner argues that, pursuant to 37 C.F.R. § 1.84(a)(2), the PTO will only accept color drawings if accompanied by a grantable petition and a statement in the specification that relates to the drawing. However, § 1.84(a)(2)(i)-(iii) clearly sets forth the materials that “[a]ny such petition must include” (emphasis added), i.e., (i) the fee in § 1.17, (ii) three sets of color drawings, (iii) certain specification language noting the existence of the color drawings (see specific language recited in 37 C.F.R. § 1.84(a)(2)(iii)). Thus, contrary to Petitioner’s argument, the required petition “must include,” as part of the petition, the specification statement to which Petitioner refers.

Petitioner further argues that the following language found in § 1.84(a)(2) supports his position: “If the language is not in the specification, a proposed amendment to insert the language must accompany the petition.” However, materials that accompany a petition are part of the petition filing and are part of the petition. In any event, § 1.84(a)(2) clearly states that the petition must “include” the proposed amendment if the particularly discussed language is not already in the specification. In view of the above, no error in grading has been shown.

Question 26 reads as follows:

26. The claimed invention in inventor Jones' application is a digital transmission system which communicates a plurality of separate digital streams over a common channel. It includes a transmitter portion (block encoding arrangements and multiplexer), and receiver portion (a demultiplexer and block decoding arrangements). The receiver portion includes a phase comparator having four inputs and one output and a divider having two inputs and one output. The functions of the phase comparator and divider are adequately disclosed in the specification. However, the specification does not describe how to make and use the phase comparator and divider. The examiner correctly and reasonably asserting that the comparator was not a typical two input phase comparator, and the divider was not a typical one input divider, properly rejected the claims under 35 U.S.C. § 112, first paragraph, for lack of enabling disclosure because the structural details of the phase comparator and divider were not disclosed. Which of the following declarations would be minimally legally sufficient to overcome this rejection in accordance with proper PTO practice and procedure?

- (A) A declaration of a professor stating that "the elements referred to in the application as the divider and the phrase [sic, phase] comparator were well-known to those of skill in the art as of June 17, 1997," the filing date of the Jones application.
- (B) A declaration of a professor stating that "the elements referred to in the application as the divider and the phase comparator were well-known to those of skill in the art as of June 17, 1997," the filing date of the Jones application, and that these elements were "routinely built."
- (C) A declaration of a professor stating that "the elements referred to in the application as the divider and the phase comparator were well-known to those of skill in the art as of June 17, 1997," the filing date of the Jones application, that these elements were "routinely built," and the professor provides details in the declaration concerning the structure and function of the elements.
- (D) A declaration of a professor stating that "the elements referred to in the application as the divider and the phase comparator were well-known to those of skill in the art as of June 17, 1997," the filing date of the Jones application, that these elements were "routinely built and sold to the public by [two identified corporations] before June 17, 1997, and were used in constructing a digital transmission system at the university."

- (E) A declaration of a professor stating that “the elements referred to in the application as the divider and the phase comparator were well-known to those of skill in the art as of June 17, 1997,” the filing date of the Jones application, that these elements were “routinely built and sold to the public by [two identified corporations] before June 17, 1997, and were used in constructing a digital transmission system at the university.” The professor was involved with the construction of the digital transmission system.

Both (C) and (D) are accepted as correct answers and Petitioner selected answer (E). The question asks which of five declarations would be minimally legally sufficient to overcome the examiner’s rejection in accordance with proper PTO practice and procedure. The declarations in both answer (C) and answer (D) state that the divider and phase comparator were “well-known to those of skill in the art as of June 17, 1997” and that these elements were “routinely built.” Answer (C) also states that the declarant “provides details in the declaration concerning the structure and function of the elements.” Choice (C) contains additional “details” so as to constitute “something more than a conclusory statement” as referred to in MPEP § 2164.05. Providing these details in the declaration directly answers the examiner’s concern about how the device is to be built and whether persons of ordinary skill in the art would know how to build the device. See fact pattern to question (“the claims [stand rejected] under 35 U.S.C. § 112, first paragraph, for lack of enabling disclosure because the structural details of the phase comparator and divider were not disclosed”) (emphasis added).

As such, credit has been given for answer (C). As explained in MPEP § 2164.05, “[t]he weight to give a declaration or affidavit will depend upon the amount of factual evidence the declaration or affidavit contains to support the conclusion of enablement.” *See also In re Buchner*, 929 F.2d 660, 661, 18 USPQ2d 1331, 1332 (Fed. Cir. 1991)

(“expert’s opinion on the ultimate legal conclusion must be supported by something more than a conclusory statement”).

The declaration in (D) states that these elements were “sold to the public by [two identified corporations] before June 17, 1997, and were used in constructing a digital transmission system at the university.” The factual evidence in (D) demonstrates that the divider and phase comparator were well known to those skilled in the art as of the filing date of the application. Again, having this statement in the declaration directly answers the examiner’s concern about how the device is to be built and whether persons of ordinary skill in the art would know how to build the device. For these reasons, (D) is a correct answer. A specification need not disclose what is well-known to those skilled in the art and may omit that which is well-known to those skilled and already available to the public. See MPEP § 2164.05(a), citing *In re Buchner*, 929 F.2d at 661, 18 USPQ2d at 1332; *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1384, 231 USPQ 81, 94 (Fed. Cir. 1986).

Answer (E) is not correct because the question asks “[w]hich of the following declarations would be minimally legally sufficient to overcome this rejection in accordance with proper PTO practice and procedure” (emphasis in original), and the declaration in (E) includes the additional statement that the professor was involved with the construction of the digital transmission system. This added statement appears in the declaration because the question begins “[w]hich of the following declarations [i.e., answer choices]” Accordingly, all in (E) is in the declaration. As set forth above, since answer (D) is a minimally legally sufficient answer, answer (E) which adds

a fact to answer (D) is more than minimally legally sufficient and is therefore an incorrect answer choice.

Petitioner argues that since the added statement does not appear in quotes, it is not part of the declaration and therefore the declaration in (E) is the same as in (D). However, as discussed above, since the answer choice follows the question “[w]hich of the following declarations [i.e., answer choices] . . .,” all that is in (E) is in the declaration, in some form. That is, the quoted portions in (E) appear exactly as such in the declaration, and the unquoted portions substantively appear in the declaration, given the wording of the question. The declaration simply has more than the quoted portions in answer choice (E). In view of the above, no error in grading has been shown.

Question 32 reads as follows:

32. In connection with an appeal to the Board of Patent Appeals and Interference’s, which of the following rejections would be a new ground of rejection?

- (A) In a final Office action, Claim 1 is rejected under 35 U.S.C. § 103 over A in view of B. On appeal, in the examiner’s answer, the primary examiner again states that Claim 1 is rejected under 35 U.S.C. § 103 over A in view of B, but the actual argument or rationale supporting the rejection, while having the same basic thrust as the argument or rationale advanced in the final rejection differs therefrom.
- (B) In a final Office action, Claim 6 is rejected under 35 U.S.C. § 103 over A in view of B, and Claim 8 is rejected under 35 U.S.C. § 103 over A in view of C. No claim was rejected under 35 U.S.C. § 103 over A in view of B and C. In reply, an amendment proposes to combine the limitations of Claims 6 and 8 together in a new claim, Claim 9, and canceling Claims 6 and 8. In an advisory action, the primary examiner permits entry of the amendment as reducing issues on appeal. On appeal, in the examiner’s answer, the primary examiner rejects Claim 9 under 35 U.S.C. § 103 over A in view of B and C, supported by the argument advanced in the rejections of Claims 6 and 8.

- (C) In a final Office action, Claims 1 and 2, where Claim 2 depends on Claim 1, are rejected under 35 U.S.C. § 103 over A in view of B. In reply, an amendment proposes to rewrite Claim 2 in independent form and cancel Claim 1. In an advisory action, the primary examiner advises that the proposed amendment will be entered as reducing issues on appeal, and that the final rejection would be used to reject Claim 2 as amended. On appeal, in the examiner's answer, the primary examiner rejects Claim 2 under 35 U.S.C. § 103 over A in view of B, supported not only by the argument advanced in the rejections of Claims 1 and 2, but also by rationale not advanced in the final rejection, though the rationale has the same thrust as the rationale in the final Office action.
- (D) In a final Office action, Claims 2 and 3 are rejected under 35 U.S.C. § 103 over A in view of B. In reply, an amendment proposes to cancel Claims 2 and 3, and add Claim 4, which incorporates the limitations of Claims 2 and 3. In an advisory action, the primary examiner advises that the proposed amendment will be entered, and that the final rejection would be used to reject the added Claim 4. On appeal, in the examiner's answer, the primary examiner rejects Claim 4 under 35 U.S.C. § 103 over A in view of B, supported by the argument advanced in the rejections of Claims 2 and 3.
- (E) In a final Office action, Claim 3 is rejected under 35 U.S.C. § 103 over A in view of B, and Claim 4 is rejected under 35 U.S.C. § 103 over A in view of C. In reply, an amendment proposes to combine the limitations of Claims 3 and 4 together in a new claim, Claim 5, and canceling Claims 3 and 4. In an advisory action, the primary examiner denies entry of the proposed amendment as not reducing issues on appeal. On appeal, in the examiner's answer, the primary examiner states that Claim 3 has been rejected under 35 U.S.C. § 103 over A in view of B, and claim 4 has been rejected under 35 U.S.C. § 103 over A in view of C, and supports the rejections by expanding upon the arguments advanced in the final Office action.

Answer (B) is the most correct choice and Petitioner selected answer (E).

The question inquires which of the five rejections would be a new ground of rejection in connection with an appeal to the Board of Patent Appeals and Interferences. Answer (B) is most correct because on appeal, and in the examiner's answer, the examiner rejects for the first time Claim 9 under 35 U.S.C. § 103 over A in view of B and C. Accordingly,

a new ground of rejection was entered. 37 CFR § 1.193(a)(2). There was no individual rejection under 35 U.S.C. § 103 in the final rejection over A in view of B and C.

Petitioner only argues that answer (D) is also correct, but he chose answer (E). By only arguing for an answer other than the one he chose, Petitioner fails to particularly point out any error in the grading of his examination, as required by 37 C.F.R. § 10.7(c). Accordingly, no additional points may be awarded to Petitioner for this question.

Question 35 reads as follows:

35. During the pendency of inventor Smith's first patent application, he filed a request for a Continued Prosecution Application (CPA). On February 4, 1998, a primary examiner again rejected Claims 1-4 in the CPA application under 35 U.S.C. § 103 over references X and Y, and again rejected Claim 5 under 35 U.S.C. § 103 over references X, Y, and Z. The examiner did not set a shortened statutory period for reply. On August 4, 1998, the practitioner filed a notice of appeal to the Board of the Patent Appeals and Interferences from the examiner's decision rejecting Claims 1-5. Claims 6-10 in the CPA application stand allowed. Which of the following actions was not in accord with proper PTO practice and procedure regarding the appeal and Smith's CPA application?

- (A) The practitioner timely filed the notice of appeal containing an authorization to charge fees to a deposit account, which is signed by the practitioner.
- (B) The practitioner timely filed the notice of appeal containing an authorization to charge the appeal fee to a deposit account which is signed by the practitioner and does not specify which claims are appealed.
- (C) The practitioner timely filed the notice of appeal containing an unsigned authorization to charge the appeal fee to a deposit account; the notice of appeal specifies which claims are appealed.
- (D) The practitioner timely filed an unsigned notice of appeal; the notice of appeal specifies which claims are appealed; a proper authorization to charge fees to a deposit account accompanied the notice of appeal.
- (E) The practitioner timely filed the notice of appeal which was signed by the practitioner; the notice of appeal specifies which claims are appealed; the appropriate fee accompanies the notice of appeal. An appeal brief was filed with a request for extension of time and the requisite fee seven months after the notice of appeal was filed.

Answer (C) is the most correct answer and Petitioner selected answer (D).

In answer (C), the practitioner is filing two items with the PTO: (1) a notice of appeal, and (2) an unsigned authorization to charge the appeal fee to a deposit account. Answer (C) is most correct because an unsigned authorization to charge the appeal fee to a deposit account does not pay the fee that is required by 37 C.F.R. §§ 1.191(a) and 1.17(b). The general rule is that papers, such as an authorization to charge a deposit account, filed in an application “must be signed.” 37 C.F.R. § 1.33(b). A notice of appeal is an exception to this general rule and need not be signed. 37 C.F.R. § 1.191(b); see also Changes in the Patent Practice and Procedure, Final Rule, 62 Fed. Reg. 53131, 53167 (October 10, 1997). However, 37 C.F.R. § 1.191(b) does not extend to or cover payment of an appeal fee by an unsigned authorization to charge a deposit account. Accordingly, answer (C) is the most correct answer to the question which action is not in accord with proper PTO practice and procedure.

Answer (D) complies with proper practice and procedure because the notice and authorization to charge the appeal fee to a deposit account is signed and claims 1-5 have been twice rejected. There is no requirement in 37 C.F.R. § 1.191 that the claims be twice rejected in the same application. Accordingly, answer (D) is not a correct answer choice to the above question asking which choice was not in accord with proper PTO practice and procedure.

Petitioner argues that, although answer (D) states that the accompanying authorization to charge fees to a deposit account is “proper,” the answer does not state that the authorization is signed, and notes that other choices state that the authorization was signed or unsigned. This argument, however, is unpersuasive because there is no

ambiguity in the use of “proper” to indicate that the authorization to charge the deposit account was in compliance with the rules. There is simply no other rational meaning of the word “proper” when used to characterize the authorization. Accordingly, no error in grading has been shown.

Question 43 reads as follows:

43. Five different situations are presented below wherein the attorney of record calls an error to the attention of the examiner. Which request (or lack of request) by the attorney, and reply by the examiner is not in accord with proper PTO practice and procedure?

- (A) An Office action dated February 11, 1998, and setting a three month shortened statutory period for reply was accompanied by a citation of references wherein a prior art patent was identified with an incorrect patent number. The attorney of record, on April 6, 1998, called the error to the attention of the examiner and requested that the examiner restart the reply period. The attorney should receive from the examiner a new citation of references correcting the error, a copy of the Office action redated, and a communication restarting the three month shortened statutory period for reply to run from the date the error is corrected.
- (B) A page of rejections is omitted from an Office action dated April 21, 1998, which set a three month shortened statutory period for reply. The attorney of record, on May 25, 1998, called the error to the attention of the examiner and requested that the examiner set a new reply period. The attorney should receive from the examiner a complete, redated Office action setting a three month shortened statutory period for reply to run from the date the error is corrected.
- (C) A copy of a patent reference is omitted from an Office action dated April 21, 1998, which set a three month shortened statutory period for reply. The attorney of record, on May 25, 1998, called the error to the attention of the examiner and requested that the reply period be reset. The attorney should receive from the examiner a copy of the omitted patent reference, and a communication resetting the reply period to be a two month shortened statutory period running from the date the error is corrected.

- (D) A copy of a patent reference was omitted from an Office action dated April 16, 1998, which set a three month shortened statutory period for reply. The attorney of record, on May 19, 1998, called the error to the attention of the examiner, but did not request that the examiner set a new reply period. The attorney should receive from the examiner a copy of the omitted patent reference with a letter noting that the time period set for reply remains as set forth in the Office action dated April 16, 1998.
- (E) A copy of a patent reference was omitted from an Office action dated March 9, 1998, which set a three month shortened statutory period for reply. The attorney of record, on July 14, 1998, called the error to the attention of the examiner and requested that the reply period be reset. The attorney should receive from the examiner a copy of the omitted patent reference with a letter noting that the time period set for reply remains as set forth in the Office action dated March 9, 1998.

The correct answers are (A) and (B) and Petitioner chose answer (C). The question presents five different situations wherein the attorney of record calls an error to the attention of the examiner and asks for the one that is not in accord with proper PTO practice and procedure. Answers (A) and (B) are the most correct answers. MPEP § 710.06 provides that “[i]f the error is brought to the attention of the Office within the period for reply set in the Office action but more than 1 month after the date of the Office action, the Office will set a new period for reply, if requested to do so by the applicant, to substantially equal the time remaining in the reply period.” Since the errors in both (A) and (B) were called to the examiner’s attention more than one month after the date of the Office action, the Office would set a new period for reply “to substantially equal the time remaining in the reply period.” Under this practice, the time remaining in the response periods for both (A) and (B) should be set at two months. As such, reference in both (A) and (B) to a “three month shortened statutory period” is not in accord with proper PTO practice and procedure. MPEP § 710.06 also provides that the Office will

set a new period for reply only if requested by the attorney. The new period must be a minimum of one month, and it runs from the date the error was corrected. MPEP § 710.06.

Unlike answers (A) and (B), answer (C) is in accord with proper PTO practice and procedure. MPEP § 710.06, first paragraph. Petitioner argues that choice (C) is correct because the fact pattern states that the attorney called the omission of the reference to the examiner's attention on May 25, 1998, which was Memorial Day, a day the PTO was officially closed, and the attorney's action was therefore not in accordance with proper PTO practice and procedure. Petitioner further argues that regardless of whether the attorney calls or writes to the examiner on that day, neither form would be in accordance with proper procedure.

Petitioner's argument is not persuasive because the date May 25, 1998, is important for purposes of how much time has lapsed since the date of the Office action. The attorney could date a paper May 25, 1998, or attempt to call the examiner on that day. For answer choice (C), the examiner may reset the time period for reply from the date the error was corrected. Accordingly, no error in grading has been shown.

Question 50:

Two points are awarded for question 50.

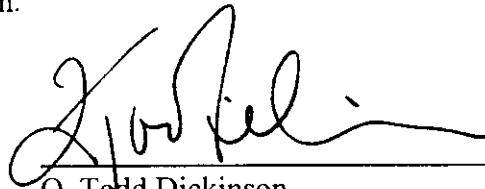
ORDER

For the reasons given above, two points have been added to Petitioner's score in the Morning Section of the Examination. Therefore, Petitioner's score is adjusted to 66. This score is insufficient to pass the Morning Section of the Examination.

Upon consideration of the petition to the Commissioner for a regrade, it is ORDERED that the request for a passing score on the Morning Section of the Examination is denied.

This is a final agency action.

AUG 24 1999

A handwritten signature in black ink, appearing to read "Q. Todd Dickinson", written over a horizontal line.

Q. Todd Dickinson
Acting Assistant Secretary of Commerce and
Acting Commissioner of Patents and Trademarks